

REMARKS

This application has been amended to place it in condition for allowance at the time of the next Official Action.

The Official Action rejects claims 1-8, 12-14 and 17 under 35 U.S.C. §103(a) as being unpatentable over KUECHLER et al. in view of KITA. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

At the outset, Applicant notes the wide disparity between the primary KUECHLER et al. reference and both the secondary reference as well as the subject matter of the present application. To best illustrate this, Applicant has reproduced below a copy of Figure 1 of KUECHLER et al. as well as text from the beginning of the DETAILED DESCRIPTION portion of such reference in column 5:

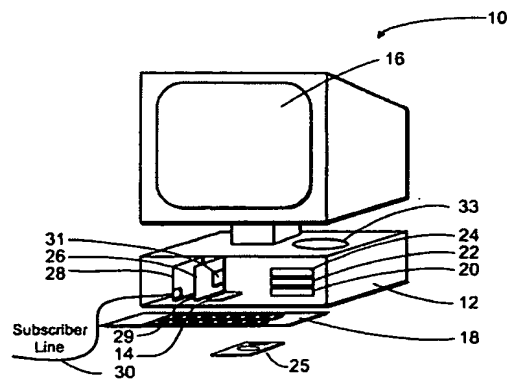


Fig. 1

Referring to FIG. 1, an apparatus for producing an audio tag in response to calling line identification information and for audibly identifying a calling party according to a first embodiment of the invention is shown generally at 10. In this embodiment, the

apparatus includes a personal computer 12 having a processor 14 in communication with a display 16, a keyboard 18, a floppy disk drive 20, for receiving a floppy disk 25, a CD ROM drive 22 and a hard disk drive 24. In addition, further connected to the processor 14 is a modem card 26 having a subscriber line interface 28 for connection to a subscriber line 30 connected to a telephone company switch (not shown). The modem card 26 and subscriber line interface act as a receiver and receiving means for receiving calling line identification information from a telephone line.

The personal computer 12 also has a sound card 29 having a digital to analog converter 31 operable to provide signals to a speaker 33 on the personal computer 12.

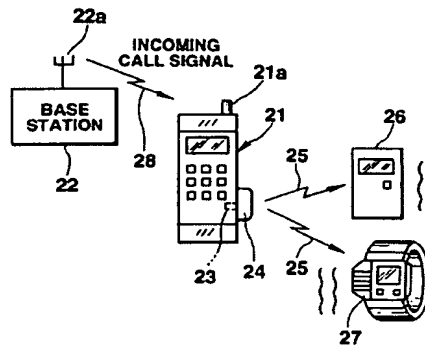
As is evident from the illustration and description above and supported by the remainder of such reference, the KUECHLER et al. patent describes a system that is meant to be implemented on a standalone personal computer in connection with a traditional land line. The primary KUECHLER et al. reference is offered for its asserted teaching or suggestion, albeit in connection with a land line and personal computer, of a telephone terminal that outputs caller identification information in voice form. The secondary KITA reference is offered for its asserted teaching or suggestion of a portable telephone terminal having an earphone/microphone, wherein the earphone/microphone outputs information when a call is received.

One of the fundamental tenets of obviousness under U.S. Patent law is the requirement that each reference so applied must be not only considered for the particular features it teaches that are applicable to the invention as claimed, but also to any

teaching or suggestion that is contrary to the invention as claimed. The KITA patent admittedly illustrates in Figures 4 and 5 a mobile telephone 21 having an earphone/microphone jack 23. The jack provides physical and electrical connection to earphone/microphone combinations 61 or 71 through plugs 62 or 72, respectively. Significantly, however, the KITA patent describes and illustrates such interconnection purely by way of background, particularly in light of the fact that the teaching of this reference is entirely away from the actual connection of earphone/microphone combinations 61 or 71 to the mobile phone.

Instead, as best illustrated in Figure 1 reproduced below, the earphone/microphone jack of the mobile phone is utilized for an entirely contrary purpose in KITA.

FIG.1



As is evident from this illustration, the device of KITA utilizes the earphone/microphone jack 23 for the connection of an incoming notification signal transmitter 24. Upon the occasion of an incoming call, the transmitter 24 sends a radio

signal to one or both of a vibrating watch 27 or vibrating card 26.

Accordingly, were one of skill in the art to be aware of the primary and secondary references, in the absence of the instruction provided by the present application, the combined teaching of the two references would be a telephone system that utilized a system using text-to-speech translation output in the form of a loud speaker such as speaker 33 of KUECHLER et al. in normal operation. However, when in a situation requiring discrete notification of an incoming call, the receiving telephone would send a radio signal to either the card 26 or the wrist device 27 of KITA to discretely inform the recipient of the incoming call. However, no reasonable combination of the primary or secondary references would teach one of skill in the art the present invention, particularly as recited in the amended claims.

Amended claim 1 specifically recites that the portable telephone terminal includes both a main portable unit and an earphone/microphone. The earphone/microphone is further described as being separate from the main portable unit.

Further, the main portable unit and the earphone/microphone are arranged so as to allow electrical interconnection therebetween. The main portable unit is also constructed so as to cause the earphone/microphone, when a call is received, to audibly output information identifying the caller

under the condition that the earphone/microphone is electrically connected to the main portable unit.

The secondary KITA reference, offered for its asserted teaching of an earphone/microphone outputting the information when a call is received, in fact teaches something entirely contrary. At best, the KITA reference may reasonably be characterized as teaching that the earphone/microphone jack on the main portable unit outputs non-identifying information when a call is received. The additional claims that depend from independent claim 1 recite further features that even more clearly distinguish such claims from the teachings of the applied references.

Throughout the present rejection, the secondary KITA reference is offered for teaching or suggesting all characteristics related to the use of the earphone/microphone unit. However, in all embodiments of KITA, the actual earphone/microphone that is available for use with the main portable unit is dispensed with. Instead, the jack on the main portable unit designed for the earphone/microphone is instead given over to the transmitter 24. Additionally, modifying the KITA device to broadcast voice data would run counter to the purpose of the KITA system, namely, the discrete notification of a phone user as to an incoming call.

The Official Action rejects claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over the combination applied in the

immediately proceeding rejection, and further in view of HERIKSSON. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

The teachings of the HERIKSSON patent are limited to a mobile phone having a selected notification feature. If the HERIKSSON phone is placed a silent service mode, only calls received from pre-identified phone numbers will result in call notification to the mobile phone user. If the source of the incoming call is not among those pre-identified, no notification to the mobile phone user is provided.

An additional embodiment of the HERIKSSON device provides for a variation in the audible alert depending on whether the receiving mobile phones placed in the silent service mode are not. However, this variation in tone is in no way an indication of the data provided with the incoming call. Instead, it is merely an indication to the mobile phone user of the mode into which the mobile phone had been placed, namely silent service mode or regular mode. When in silent service mode, the identification of the source of the incoming call is purely binary, namely, an indication is provided or no such indication is provided.

In contrast, present claims 9-11 describe an entirely different system. As recited in claim 9, the mobile phone generates voice data through the earphone in the event that the incoming caller data corresponds to data pre-stored by the user.

In the absence of such correspondence, the voice data provided through the earphone is instead the caller data itself, such as the incoming phone number.

Claims 10 and 11 provide a third option. If the incoming call bears no caller data, then the user of the mobile phone is informed by voice through the earphone of such condition. Accordingly, the combination of the three references still fails to teach or suggest the full set of features recited in the rejected claims.

The Official Action rejects claim 15 under 35 U.S.C. §103(a) as being unpatentable in view of KUECHLER et al. and KITA and further in view of SAKANOUÉ. The Official Action also rejects claim 16 under 35 U.S.C. §103(a) as unpatentable over KUECHLER et al. in view of KITA and further in view of MALONEY. In the case of each of these rejections, the additional reference is offered for the additional feature recited in dependent claims 15 and 16, respectively. However, irrespective of the ability of these references to teach or suggest that for which there are specifically offered, they still fail to overcome the shortcomings of the KUECHLER et al. and KITA references for the reasons described above in connection with the preceding obviousness rejection.

Entry of the above amendments is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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